

REMARKS/ARGUMENTS

Claims 1-8, 12, 13, 17, 19-26, 30, 31, 35-42, 46 and 47 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103. Obviousness

The Examiner rejected Claims 1-3, 6-8, 12, 13, 17, 19-21, 24-26, 30, 31, 35-37, 40-42, 46 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Angiulo et al (US Publication 2002/0135621). This rejection is respectfully traversed.

In rejecting Claim 1, the Examiner acknowledges that the cited Angiulo reference does not disclose reordering elements when the selected set of elements comprises a plurality of non-contiguous elements. The Examiner then states:

"The Examiner takes Official notice that selection of multiple non-contiguous elements within a list of elements would have been obvious to one of ordinary skill in the art."

Applicants urge legal error in such assertion as follows. As stated in the Manual of Patent Examiner Procedures (MPEP):

2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art [R-1]

In limited circumstances, it is appropriate for an examiner to take **official notice of facts** not in the record or to rely on "common knowledge" in making a rejection, however such rejections should be judiciously applied (emphasis added by Applicants).

PROCEDURE FOR RELYING ON COMMON KNOWLEDGE OR TAKING OFFICIAL NOTICE

The standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA). See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000). See also MPEP § 1216.01. In light of recent Federal Circuit decisions as discussed below and the substantial evidence standard of review now applied to USPTO Board decisions, the following guidance is provided in order to assist the examiners in determining when it is appropriate to take **official notice of facts** without supporting documentary evidence or to rely on common knowledge in the art in making a rejection, and if such official notice is taken, what evidence is necessary to support the examiner's conclusion of common knowledge in the art (emphasis added by Applicants).

A. Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner's Conclusion

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner **where the facts asserted to be well-known**, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), **the notice of facts** beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)) (emphasis added by Applicants).

As can be seen, official notice is only permissible in extremely limited circumstances, and can only be used with respect to 'facts'. However, the Examiner takes official notice as to a legal conclusion – that the invention is obvious – which is clear error (again, as stated by the Examiner in rejecting Claim 1: "The Examiner takes **Official notice** that selection of multiple non-contiguous elements within a list of elements **would have been obvious** to one of ordinary skill in the art." (emphasis added by Applicants). Thus, at least for this reason alone, the Examiner has erroneously rejected Claim 1 under 35 USC 103.

Further with respect to Claim 1, it is urged that a proper prima facie showing of obviousness has not been established, as all of the claim limitations are not taught or suggested by the cited reference¹. Accordingly, the burden has not shifted to Applicants to rebut such improper obviousness assertion². In addition, as a proper prima facie showing of obviousness has not been established, Claim 1 has been

¹ To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added).

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

erroneously rejected under 35 USC 103³. As all other statutory requirements have been met, Applicants are entitled to a patent at least with respect to Claim 1⁴.

Still further with respect to Claim 1, it is urged that since Angoulo himself appreciated that multiple discontinuous images could be selected (page 5, paragraph 0045), but limits the discussion of such selection to a Delete operation, and specifically limits images that can be moved Up or Down to only apply to a single or contiguous images (page 6, paragraph 0044), this is itself evidence that the movement or re-ordering of non-contiguous elements in a list was not obvious, otherwise Angoulo himself would have provided such functionality. Since Angoulo is presumably one of ordinary skill in the art, this omission of functionality by Angoulo itself evidences that the missing claimed feature was not obvious to one of ordinary skill in the art.

Still further, because the images listed in the list can be linked to a resulting photo gallery, and the order of the images in the list determines the order of the images in the photo gallery (page 6, paragraph 0046-0047), it would have not been obvious to provide the claimed missing feature regarding non-contiguous elements due to resulting complexities that would occur with respect to the linked photo gallery.

Applicants have thus shown numerous reasons why Claim 1 has been erroneously rejected, and why Claim 1 would not have been obvious to one of ordinary skill in the art, and thus requests that the rejection of Claim 1 be withdrawn, and allowed.

Applicants initially traverse the rejection of Claims 2, 3, 6-8, 12, 13, 17, 19-21, 24-26, 30, 31, 35-37, 40-42, 46 and 47 for similar reasons to those given above with respect to Claim 1.

Further with respect to Claim 8, it is urged that the cited reference does not teach or suggest the claimed features of "determining whether the set of elements can be moved in the direction identified by the second user input" and "responsive to a determination that the set of elements can be moved in the direction, moving the set of elements in the direction". As can be seen, Claim 8 recites an explicit step of determining whether the set of elements can be moved, and then goes on to state that the set of elements are moved *responsive to a determination that the set of elements can be moved*. In rejecting Claim 8, the Examiner cites Angoulo's teachings at page 6, paragraphs 46 and 47 as this passage describes a MOVE UP and MOVE DOWN button. Applicants urge that a mere description of Up and Down buttons does

³ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

⁴ In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

not teach or otherwise suggest the claimed determining step, and since there is no determining step taught/suggested, it necessarily follows that there is no 'moving' step that is done in response to such (missing) determining step. Thus, as there are at least two steps of Claim 8 which are not taught/suggested by the cited reference, it is further shown that a proper prima facie case of obviousness has not been established by the Examiner, and thus Claim 8 has been erroneously rejected.

Applicants further traverse the rejection of Claims 26 and 42 for similar reasons to the further reasons given above with respect to Claim 8.

Therefore, the rejection of Claims 1-3, 6-8, 12, 13, 17, 19-21, 24-26, 30, 31, 35-37, 40-42, 46 and 47 under 35 U.S.C. § 103 has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 4, 5, 22, 23, 38 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Angiulo et al (US Publication 2002/0135621) in view of Examiner Automated Search Tool. This rejection is respectfully traversed.

Applicants initially traverse such rejection for similar reasons to those given above with respect to Claim 1.

Still further, the EAST.EXE executable file whose functions are being demonstrated by the provided screen shots of the Examiner Automated Search Tool (EAST) is dated 06/02/2004 (Figure 1), and thus this cited EAST reference does *not* predate the effective filing date of the present invention, which is 5/24/2001. Therefore, the cited EAST reference is not a valid 35 USC 103 reference with respect to the present application. Therefore, Claims 4, 5, 22, 23, 38 and 39 are further shown to have been erroneously rejected under 35 U.S.C. § 103.

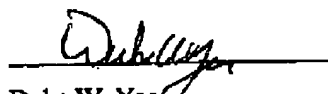
Therefore, the rejection of Claims 4, 5, 22, 23, 38 and 39 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,


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